

**Remarks**

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 37, 39-62 and 69-74 are pending in the application, with claims 37 and 69 being the independent claims, and with claim 52 being withdrawn from consideration. Claims 1-36 and 63-68 have been cancelled without prejudice to or disclaimer of the subject matter therein. Claims 37 and 69 have been amended, and new claims 70-74 are sought to be added. Support of the amendments to claims 37 and 69 and new claims 70-74 appears throughout the specification as filed, including, *inter alia*, in Figures 2-4 and accompanying description at page 12, line 22, to page 16, line 4. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

***Rejections under 35 U.S.C. § 103***

Claims 37, 39-51, 53-62 and 69 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,096,037 to Mulier *et al.* ("Mulier") in view of U.S. Patent No. 5,562,702 to Huitema *et al.* ("Huitema") and U.S. Patent No. 6,032,674 to Eggers *et al.* ("Eggers").

The Examiner asserts that Figure 12 of Mulier discloses a device including first and second clamps movable relative to each other. Office Action, page 3. The Examiner further asserts that the upper and lower clamps of Mulier each have first and second jaw

members forming a loop. *Id.* The Examiner recognizes that Mulier fails to specifically disclose a dimensional change sensor, but asserts that Huitema discloses that it is known to include sensors in forceps jaws for measuring tissue thickness. *Id.* The Examiner recognizes that Huitema fails to disclose the type and placement of the thickness measuring sensor, but asserts that Eggers discloses a dimensional change sensor which is an ultrasound sensor. *Id.* The Examiner concludes that it would have been obvious to provide the Mulier forceps device with a sensor for measuring tissue thickness since Huitema discloses that it is known to provide tissue thickness sensors on forceps devices and since Eggers discloses that it is known to use a surface mounted sensor to monitor tissue thickness. *Id.*

Applicants respectfully traverse this rejection. Each of independent claims 37 and 69 have been amended to recite:

the first and second jaw members of the first clamp being configured in an opposing manner to grasp tissue therebetween when the first and second jaws of the first clamp are moved together, and the first and second jaw members of the second clamp being configured in an opposing manner to grasp tissue therebetween when the first and second jaws of the second clamp are moved together; and

wherein the first jaw members of the first and second clamps are configured to move in correspondence with the dimensional change of the tissue, wherein the at least one electrode is disposed between either the first jaw members of the first and second clamps or the second jaw members of the first and second clamps to treat tissue grasped by the jaw members of the first and second clamps such that the dimensional change in the tissue caused by such treatment will cause a corresponding change in the distance between the first jaw members of the first and second clamps.

As shown, for example, in the embodiment of Figures 2-4 of the present application, a first clamp 140 has jaw members 140a and 140b that can grasp the tissue (see arrow  $D_C$  in Figure 3). Each of jaw members 140a and 140b can also move laterally relative to respective jaw members 160a and 160b of a second clamp 160 and relative to the expansion and/or contraction of the tissue 180 being treated (see Figure 4). Thus, a dimensional change in the tissue being treated can cause a corresponding change in the distance between the first jaw members 140a and 160a of the respective clamps 140 and 160, and likewise can cause a corresponding change in the distance between the second jaw members 140b and 160b of the respective clamps 140 and 160 (see arrow  $D_L$  in Figure 2 and arrows in Figure 5).

None of the cited references, alone or in combination, disclose the dimensional change sensor of the presently claimed invention. As noted above, the Examiner asserts that Figure 12 of Mulier disclose upper and lower clamps which each have first and second jaw members forming a loop. Consequently, in Mulier, the jaw members of a clamp are not "configured in an opposing manner to grasp tissue therebetween," as claimed. Moreover, in Mulier, the jaw members of a clamp cannot be moved together as claimed, since the jaw members form a loop and hence are fixed in position relative to each other. Mulier also does not disclose that a dimensional change in the tissue will cause a corresponding change in the distance between the first jaw members of the upper and lower clamps.

Establishment of a *prima facie* case of obviousness requires that the Examiner factually show that the references in combination disclose *all* of the elements of the claims in their proper function, as well as provide a reasoned articulation that the

combination of elements would have been known to produce a predictable result. In the present case, this burden has not been met. Mulier does not teach each and every element of the present independent claims 37 and 69. Huitema and Mulier do not cure the deficiencies of Mulier with respect to these claims, nor any of the claims that depend therefrom. Since even a combination of cited references does not teach each and every element of the present claims, then the cited references cannot therefore render obvious the present claims.

For at least the foregoing reasons, the Examiner has therefore failed to establish a *prima facie* case of obviousness. Accordingly, amended claims 37 and 69, and claims 39-62 and new claims 70-74 which depend from claims 37 and 69 are patentable over the cited references. Applicants therefore respectfully request these rejections be reconsidered and withdrawn.

### ***Conclusion***

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,  
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